



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/627,206 | 07/27/2000 | Jane A. Gross | 98-75C2 | 1238 |

7590 04/26/2002
Phillip B C Jones J D Ph D
ZymoGenetics Inc
1201 Eastlake Avenue East
Seattle, WA 98102

EXAMINER

ZEMAN, ROBERT

ART UNIT PAPER NUMBER

1645

DATE MAILED: 04/26/2002

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/627,206

Applicant(s)

GROSS, JANE A.

Examiner

Robert A Zeman

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 15 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 89-116 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 89-116 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Applicant's election with traverse of Group 60 in Paper No. 8 is acknowledged.

The request for the deletion of an inventor in this nonprovisional application under 37 CFR 1.48(b) is deficient because: It lacks the required fee under 37 CFR 1.17(i).

The amendment filed on 2-15-2002 is also acknowledged. Claims 1-88 have been canceled. Claims 89-116 have been added and are subject to the restriction requirement set forth below.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 89-97, drawn to methods of inhibiting B cell proliferation by administering a composition comprising a soluble ztnf4 receptor wherein said ztnf4 receptor is a soluble form of the TACI polypeptide, classified in class 424, subclass 185.1.
- II. Claims 89 and 98-101, drawn to methods of inhibiting B cell proliferation by administering a composition comprising a soluble ztnf4 receptor wherein said ztnf4 receptor is a soluble form of the BCMA polypeptide, classified in class 424, subclass 185.1.
- III. Claims 89 and 102-111, drawn to methods of inhibiting B cell proliferation by administering a composition comprising a soluble ztnf4 receptor wherein said ztnf4 receptor is a soluble form of the TACI polypeptide fused to an immunoglobulin, classified in class 424, subclass 134.1.

Art Unit: 1645

- IV. Claims 89, 102-106 and 112-116, drawn to methods of inhibiting B cell proliferation by administering a composition comprising a soluble ztnf4 receptor wherein said ztnf4 receptor is a soluble form of the BCMA polypeptide fused to an immunoglobulin, classified in class 242, subclass 134.1.

The inventions are distinct, each from the other because of the following reasons:

Groups I-IV are separate and distinct from each other as they are drawn to differing methods using differing compositions.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Art Unit: 1645

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A Zeman whose telephone number is (703) 308-7991.

The examiner can normally be reached on M-Th 7:30 am - 5:00 pm and Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donna Wortman can be reached on (703) 308-1032. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



DONNA WORTMAN
PRIMARY EXAMINER

Robert A. Zeman
April 25, 2002